

Remarks

Applicant respectfully requests reconsideration and that the case pass to issue in light of the amendments above and the remarks below.

Office Action Summary

1. Claims 26-32 and 35-38 stand rejected under 35 U.S.C. § 112, first paragraph.

2. Claims 14-38 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over USPN 5,050,591 to Sandrin in view of USPN 3,045,254 to Cook.

Rejections Under 35 U.S.C. § 112

Claims 26-32 and 35-38 stand rejected under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement. Applicant believes each of the claims to comply with the requirements under 35 U.S.C. § 112, first paragraph, and that the written description reasonably conveys possession of the invention recited in each of the rejected claims.

Applicant submits the Examiner failed to set forth the proper rejection under 35 U.S.C. § 112, first paragraph. As noted in MPEP § 2163.04, the Examiner has an initial burden to represent evidence of why a person skilled in the art would not recognize in Applicant's disclosure a description of the invention defined by the claims.

The Examiner's initial burden requires the Examiner to at least set forth express findings of facts which support the lack of written description conclusion. These findings should include: (a) identifying the claim limitations at issue; and (b) establishing a prima facie case by providing reasons why a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the invention as claimed. MPEP §

2163.04 goes further to state that a general allegation is not a sufficient reason to support a rejection for lack of adequate written description.

The rejection set forth by the Examiner is reproduced below:

Claims 26-32 and 35-38 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant has claimed a myriad of limitations with respect to the structure, shape, and positioning of foam blocks. Examiner respectfully points out that page 6, lines 8-10 provide the only mention of the foam blocks, and fails to recite any of the claimed structural limitations.

The Examiner failed to identify the claim limitations at issue and failed to establish reasons why a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the claimed invention. The Examiner has simply set forth a general allegation without specifically identifying the limitations at issue. Because the Examiner has failed to meet the initial burden of at least identifying the limitations at issue, Applicant is unsure how best to address the Examiner's concerns.

As noted in MPEP § 2163.02, Applicant is permitted to show possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention. The subject matter claimed need not be described literally (i.e., using the same terms *in haec verba*) in order for the disclosure to satisfy the written description requirement. While Applicant cannot be sure as to the limitations at issue, Applicant points out that the limitations recited in the pending claims find support in originally filed Figures 2 and 3 and throughout the specification.

Applicant respectfully requests the Examiner to provide a preponderance of evidence why a person skilled in the art would not recognize the claimed invention, or at least,

the Examiner should be required to identify the claim limitations at issue. Applicant respectfully requests that any further rejection on this subject matter should be made non-final so that Applicant has an appropriate opportunity to address the Examiner's concerns, and if necessary, to file any clarifying amendments.

Rejection Under 35 U.S.C. § 103

Claims 14-38 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Sandrin and Cook patents. Applicant submits that there is no motivation to combine the Sandrin and Cook patents and that even the improper combination thereof still fails to teach the claimed invention.

As noted in the previously filed Appeal Brief, Applicant attempted to argue that it would not be obvious to modify the bathmat of the Sandrin patent to use the foam of the Cook patent within the sealed channel 31 since it would render the Sandrin patent unsatisfactory for its intended purpose. The decision by the Board on this issue was not conclusive and did not confirm that there was motivation to combine the Sandrin and Cook references. The Board simply noted that Appellant failed to provide a persuasive argument or evidence that modifying Sandrin to use the foam of the Cook patent would have been beyond the skill of a person of ordinary skill in the art.

Applicant again reiterates that the Sandrin patent would be rendered unsatisfactory for its intended purpose if it was modified to include the foam of the Cook patent. In particular, the Sandrin patent relies upon a compressed air flow to inflate a first channel 31 and a second channel 32. The same compressed air flows through both of the channels 31 and 32. If one of the channels was modified in light of the Cook patent to include foam, the compressed air would not properly flow through the channels 31 and 32. Because the air flow would be inadequate, the Sandrin mat would not properly inflate. Because it would not properly inflate, modifying it to include the foam of the Cook patent would render it unsatisfactory for its intended purpose. As such, Applicant submits that it is improper for the Examiner to combine the Sandrin and Cook patents in rejecting the pending claims.

Applicant also points out that the Examiner has failed to set forth a prima facie case of obviousness at least with respect to claims 27-38. Claims 27-38 relate to claims added by Applicant in the last filed response and are addressed to particularly important subject matter that is believed to be patentable and nonobvious over the Sandrin and Cook patents. The Examiner's rejection fails to provide a convincing line of reasoning as to why subject matter of those claims are taught by the cited art. The Examiner should be required to at least address the important limitations of each of those claims and to set forth a more detailed analysis as to why those claims are obvious over the cited art. Applicant submits that any further action against these claims in light of the Sandrin and Cook patents should be made non-final so that Applicant has an opportunity to properly address each of the concerns raised by the Examiner.

Conclusion

In view of the foregoing, Applicant respectfully submits that each rejection has been fully replied to and traversed and that the case is in condition to pass to issue. The Examiner is respectfully requested to pass the case to issue and is invited to contact the undersigned if it would further prosecution of the case to issue.

Please charge any fees or credit any overpayments as a result of the filing of this paper to our Deposit Account No. 02-3978.

Respectfully submitted,

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